

REMARKS

Applicant has carefully reviewed the Application in light of the Final Office Action mailed December 23, 2004. At the time of the Office Action, Claims 1-33 were pending in the Application. Applicant amends Claim 33 without prejudice or disclaimer. The amendment to the claim is not the result of any prior art reference and, thus, does not narrow the scope of any of the claims. Furthermore, the amendment is not related to patentability issues and only further clarifies subject matter already present. Applicant's amendment has only been done in order to advance prosecution in this case. Applicant respectfully requests reconsideration of the pending claims and favorable action in this case.

Section 112 Rejection

The Examiner rejects Claim 33 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Applicant has made a minor amendment to address the Examiner's concern and, thereby, overcome the rejection.

Section 103 Rejections

The Examiner rejects Claims 1-17, 23-28, and 30-33 under 35 U.S.C. § 103(a) as being anticipated by U.S. Patent No. 6,646,997 issued to Baxley et al. (hereinafter "*Baxley*") in view of U.S. Patent No. 5,369,694 issued to Bales et al. (hereinafter "*Bales*"). The Examiner rejects Claims 18-22 under 35 U.S.C. § 103(a) as being unpatentable over *Baxley* in view of U.S. Patent No. 6,671,262 issued to Kung et al. (hereinafter "*Kung*"). The Examiner rejects Claim 29 under 35 U.S.C. § 103(a) as being unpatentable over *Baxley* and *Bales* as applied to Claim 28 above, and further in view of U.S. Publication No. 2003/0125954. Applicant respectfully traverse these rejections for the reasons stated below.

Applicant respectfully reminds the Examiner that to establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation; either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the prior reference (or references when combined) must teach or suggest all of the claim limitations. (See M.P.E.P. §2142-43.)

It is respectfully submitted that Claim 1 is patentable over the art of record based on at least the third criterion of obviousness: none of the references alone or in combination teach, suggest, or disclose each and every claim limitation.

Independent Claim 1 recites:

A method for conducting a transfer of a conference call, comprising:
receiving media streams from a plurality of endpoints participating in a conference call;
receiving a message at a media gateway to transfer responsibility for mixing of the media streams from a first call resource to a second call resource;
transferring responsibility for mixing of the media streams from the first call resource to the second call resource based on the message; and
communicating a prompt to the clients during the transfer of responsibility for mixing of the media streams if the message indicates a change in the number of clients participating in the conference call, the prompt operable to mask the transfer of responsibility for mixing of the media streams between the first and second call resources.

In contrast to this, *Baxley* discloses a large-scale, fault-tolerant audio conferencing system in a packet-switched network. (See Abstract of *Baxley*.) Evaluating *Baxley* more carefully reveals that it cannot inhibit the patentability of the pending claims because it fails to offer any prompt, as is recited in Independent Claim 1. Indeed, the Examiner concedes this point (See Current Office Action: page 4), but mistakenly offers *Bales* to fill this void. However, reliance on *Bales* is simply flawed because *Bales* offers an audio conferencing architecture that is different from the subject matter of the present invention. *Bales* is different for at least the reason that it fails to offer a system capable of transferring any type of responsibility.

This point was also conceded by the Examiner in the previous action (See Previous Response: dated 8/12/04). Once Applicant pointed out this discrepancy to the Examiner in the preceding Response, *Bales* miraculously morphed from a §102 reference to a §103 reference. Having acknowledged this deficiency of *Bales*, it is clear that *Bales* cannot be used to offer the missing prompt feature, which is precisely related to the transferring responsibility that is missing in *Bales*. Hence, if *Bales* cannot perform the transferring responsibility operation, then *Bales* cannot provide the missing prompt feature that is associated with the very transferring responsibility operation. *Bales* has no context for this element. The Examiner is precluded from using any such combination, as it is contradictory and, thus, improper.

Independent Claims 6, 10, and 14 recite limitations similar, but not identical, to those recited in Independent Claim 1. Therefore, these claims are also allowable, for example, for the same reasons as identified above. Additionally, the corresponding dependent claims from these Independent Claims are also patentably distinct for analogous reasons.

Applicant would welcome the opportunity provide additional arguments for the Examiner to consider and that address the remaining claims. However, Applicant is unable to do so at this time. In regards to Independent Claim 33, the Examiner is yet to identify any part of the cited references to support his rejection. With respect to cited portions of *Baxley*, there appears to be some confusion as to the where the Examiner is directing Applicant. For example, the Examiner cites the same portions of *Baxley* no-less-than 7 times in rejecting claims 1, 6, 10, 14, 23, and 25; but the cited portions (Col. 11: lines 1-15 or lines 10-15) are clearly erroneous. Applicant has reviewed the cited passages several times but cannot find any teachings for the associated claim limitations. Applicant presumes this to be an oversight by the Examiner. This oversight is significant, as Applicant cannot respond properly to the Office Action. Applicant respectfully urges the Examiner to review the Office Action and to correct these mistakes so Applicant can further explain the allowability of the pending claims.

CONCLUSION

Applicant has now made an earnest attempt to place this case in condition for immediate allowance. For the foregoing reasons and for all other reasons clear and apparent, Applicant respectfully requests reconsideration and allowance of the pending claims.

Applicant believes no fee is due. However, if this is not correct, the Commissioner is hereby authorized to charge any additional fees or credit any overpayments to Deposit Account No. 02-0384 of Baker Botts, L.L.P.

If there are matters that can be discussed by telephone to advance prosecution of this application, Applicant invites the Examiner to contact Thomas Frame at 214.953.6675.

Respectfully submitted,
BAKER BOTTS L.L.P.
Attorneys for Applicant



Thomas Frame
Reg. No. 47,232

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Customer No. **05073**